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EXAMINER
MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
2131	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/772,025	RISAN ET AL.
Office Action Summary	Examiner	Art Unit	
	Aravind K. Moorthy	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 November 2007*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the amendment filed on 13 November 2007.

2. Claims 1-35 are pending in the application.

3. Claims 1-35 have been rejected.

Response to Amendment

4. The examiner approves of the amendment made to independent claims 1, 15 and 22. No new matter has been added.

Response to Arguments

5. Regarding the double patenting rejection, the applicant contends that a terminal disclaimer has been filed. The examiner asserts that the office has not received a terminal disclaimer from the applicant. Therefore, the examiner maintains the double patenting rejection.

6. On page 10, the applicant argues that the trademarks "iTunes", "iPod", "Macintosh" and "Windows" with further reference to an operating system has a fixed and definite meaning to provide sufficient identification of the operating system characteristics.

The examiner respectfully disagrees. If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a

claim to identify or describe a material or product would not only render a claim indefinite, but

would also constitute an improper use of the trademark or trade name.

7. Regarding the prior art rejection, the Applicant's arguments with respect to claims 1-35 have

been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8.   Claims 1, 3, 9-15, 19, 20, 22, 24 and 30-35 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/325243. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 10/325243 application is directed towards a method of preventing unauthorized recording of electronic media. The 10/325243 application teaches activating a compliance mechanism, controlling a data output path and directing media content to a custom media device.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

9.   Claims 1, 9-15, 19, 20, 22 and 30-35 provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claim1-3 and 5-9 of copending

Application No. 10/364643. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the 10/364643 application is directed towards a

method of preventing unauthorized recording of electronic media. The 10/364643 application

teaches activating a compliance mechanism, controlling a data output path and directing media

content to a custom media device.

        This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

        Claims 1, 2, 4-10, 13, 15, 16, 18-20, 22, 23, 25-31 and 34 contain the trademark/trade

name iTunes, iPod, Macintosh and Windows. Where a trademark or trade name is used in a

claim as a limitation to identify or describe a particular material or product, the claim does not

comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218

USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name

cannot be used properly to identify any particular material or product. A trademark or trade

name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or

trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a media service, a media player and operating systems and, accordingly, the identification/description is indefinite. For the sake of examining, the examiner will assume iTunes to be a media player, iPod to be a media playing device, and Macintosh and Windows to be any operating system.

Any claims not directly addressed are rejected on the virtue of their dependency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. **Claims 1-20 and 22-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doherty et al U.S. Patent No. 6,920,567 B1 in view of Pastorelli et al US 2004/0133801 A1.**

As to claim 1, Doherty et al discloses a method of preventing unauthorized recording of electronic media comprising:

activating a compliance mechanism in response to receiving media content at a client system from a content provider providing content in a format compatible with an iTunes™ media service, the compliance mechanism coupled to the client system, the client system having a media content presentation application capable of handling the media content operable thereon and coupled to the compliance mechanism [column 4, lines 15-34];

controlling a data output path carrying the media content of the client system with the compliance mechanism [column 4, lines 15-34]; and

directing the media content to a custom media device coupled to the compliance mechanism via the data output path, for selectively restricting output of the media content [column 4, lines 15-34].

Doherty et al does not teach diverting a commonly used data pathway of the media content presentation application to a controlled data pathway monitored by the compliance mechanism.

Pastorelli et al teaches intercepting an execution request. Compliance of the execution request with authorized conditions is verified. Starting of the product is enabled or prevented according to the result of the verification [0045].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Doherty et al so that once an execution request of a product is made, it would be intercepted. Compliance of the execution request would have been verified. Starting of the product would have been enabled or prevented according to the result of the verification.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Doherty et al by the teaching of Pastorelli et al because it allows programs running on the device to be controlled in real-time. In this way, a very effective licensing validation is carried out at low cost [0046].

As to claims 2 and 23, Doherty et al teaches that the custom media device comprises an iTunes™ [Figure 1D].

As to claims 3 and 24, Doherty et al teaches the method further comprising:

restricting the client system to have the custom media device implemented

as a default media device [column 7, lines 4-8].

As to claims 4 and 25, Doherty et al teaches the method further comprising:

interfacing with the iTunes™ media service through the media content

presentation application that comprises an iTunes™ application [column 10 line

24 to column 11 line 20].

As to claims 5 and 26, Doherty et al teaches that the client system operates a

Macintosh™ operating system [column 10 line 24 to column 11 line 20].

As to claims 6 and 27, Doherty et al teaches that the client system comprises an iPod™

[Figure 1D].

As to claims 7, 18 and 28, Doherty et al teaches the method further comprising:

interfacing with the iTunes™ media service through the media content

presentation application that comprises a Windows compatible iTunes™

application [column 10 line 24 to column 11 line 20].

As to claims 8 and 29, Doherty et al teaches that the client system operates a Windows™

operating system [column 10 line 24 to column 11 line 20].

As to claims 9, 19 and 30, Doherty et al teaches the method further comprising:

preventing a recording application coupled to the client system from

recording the media content when the recording the media content does not

comply with at least one usage restriction applicable to the media content as

applied by the iTunes™ media service [column 10, lines 10-23].

As to claims 10, 20 and 31, Doherty et al teaches the method further comprising:

allowing a recording application coupled to the client system for recording the media content when the recording the media content complies with usage restrictions applicable to the media content as applied by the iTunes™ media service [column 10, lines 10-23].

As to claims 11 and 32, Doherty et al teaches the method further comprising:

authorizing the client system to receive the media content [column 3, lines 17-19; column 5, lines 42-43; column 9, line 60].

As to claims 12 and 33, Doherty et al teaches the method further comprising:

accessing an indicator associated with the media content for indicating to the compliance mechanism that a usage restriction is applicable to the media content [column 8, lines 1-6].

As to claims 13 and 34, Doherty et al teaches the method further comprising:

altering the compliance mechanism in response to a change in a usage restriction applicable to the media content as applied by the iTunes™ media service, wherein the usage restriction comprises a copyright restriction or licensing agreement applicable to the media content [column 12, lines 35-47].

As to claims 14 and 35, Doherty et al teaches that the media content is received from a source coupled to the client system, the source from the group consisting of: a network, an electronic media device, a media storage device, a media storage device inserted in a media device player, a media player application, and a media recorder application [column 5, lines 34-36; column 7, lines 63-66; Figure 1D].

As to claim 15, Doherty et al discloses a method of preventing unauthorized recording of electronic media comprising:

activating a compliance mechanism in response to handling media content at a client system that is operating a Windows ^{TM} operating system, wherein the content complies with a format compatible with a Windows^{TM} compatible iTunes^{TM} media service, the compliance mechanism coupled to the client system [column 4, lines 15-34];

controlling a data output path carrying the media content of the client system with the compliance mechanism [column 4, lines 15-34]; and

directing the media content to a custom media device coupled to the compliance mechanism via the data output path, for selectively restricting output of the media content [column 4, lines 15-34].

Doherty et al does not teach diverting a commonly used data pathway of the media content presentation application to a controlled data pathway monitored by the compliance mechanism.

Pastorelli et al teaches intercepting an execution request. Compliance of the execution request with authorized conditions is verified. Starting of the product is enabled or prevented according to the result of the verification [0045].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Doherty et al so that once an execution request of a product is made, it would be intercepted. Compliance of the execution request would have

been verified. Starting of the product would have been enabled or prevented according to the result of the verification.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Doherty et al by the teaching of Pastorelli et al because it allows programs running on the device to be controlled in real-time. In this way, a very effective licensing validation is carried out at low cost [0046].

As to claim 16, Doherty et al teaches the method further comprising:

> receiving the media content from a content provider providing content in a format compatible with the iTunes™ media service [column 10 line 24 to column 11 line 20].

As to claim 17, Doherty et al teaches the method further comprising:

> receiving the compliance mechanism in a package that contains the media content [column 10 line 24 to column 11 line 20]; and

> installing the compliance mechanism on the client system [column 10 line 24 to column 11 line 20].

As to claim 22, Doherty et al discloses a computer system comprising:

> a processor [column 10, lines 24-65]; and

> a computer readable memory coupled to the processor and containing program instructions that, when executed, implement a method of preventing unauthorized recording of electronic media [column 10, lines 24-65] comprising:

>> activating a compliance mechanism in response to receiving media content at a client system from *a* content provider providing content in a

format compatible with an iTunesTM media service, the compliance

mechanism coupled to the client system, the client system having a media

content presentation application capable of handling the media content

operable thereon and coupled to the compliance mechanism [column 4,

lines 15-34];

controlling a data output path carrying the media content of the

computer system with the compliance mechanism [column 4, lines 15-

34]; and

directing the media content to a custom media device coupled to

the compliance mechanism via the data output path, for selectively

restricting output of the media content [column 4, lines 15-34].

Doherty et al does not teach diverting a commonly used data pathway of the media

content presentation application to a controlled data pathway monitored by the compliance

mechanism.

Pastorelli et al teaches intercepting an execution request. Compliance of the execution

request with authorized conditions is verified. Starting of the product is enabled or prevented

according to the result of the verification [0045].

Therefore, it would have been obvious to a person having ordinary skill in the art at the

time the invention was made to have modified Doherty et al so that once an execution request of

a product is made, it would be intercepted. Compliance of the execution request would have

been verified. Starting of the product would have been enabled or prevented according to the

result of the verification.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Doherty et al by the teaching of Pastorelli et al because it allows programs running on the device to be controlled in real-time. In this way, a very effective licensing validation is carried out at low cost [0046].

12. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doherty et al U.S. Patent No. 6,920,567 B1 and Pastorelli et al US 2004/0133801 A1 as applied to claim 15 above, and further in view of Rhoads et al U.S. Patent No. 6,442,285 B2.

As to claim 21, the Doherty-Pastorelli combination does not teach accessing a watermark associated with the media content for indicating to the compliance mechanism that a usage restriction is applicable to the media content.

Rhoads et al teaches accessing a watermark associated with the media content for indicating to the compliance mechanism that a usage restriction is applicable to the media content [column 10, lines 22-30].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Doherty-Pastorelli combination so that the media content would have been marked with a watermark to indicate to the compliance mechanism that a usage restriction is applicable to the media content.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Doherty-Pastorelli combination by the teaching of Rhoads et al because the watermark can control different levels of use of the media (i.e. no playback, single playback, two playbacks etc.) [column 6, lines 19-54].

Conclusion

13.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aravind K Moorthy AM
January 27, 2008

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